

**REMARKS**

At the time of the Final Office Action dated October 17, 2005, claims 1-6 were pending and rejected in this application. Independent claims 1, 3, and 5 have been amended to clarify that different ones of location-based service providers specify different formats for receiving request, and this amendment finds adequate descriptive support throughout the originally-filed disclosure, for example, in the paragraph spanning pages 8 and 9. Applicants submit that the present Amendment does not generate any new matter issue.

**CLAIMS 1-6 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY  
REQUENA ET AL., U.S. PATENT PUBLICATION NO. 2002/0126701 (HEREINAFTER REQUENA)**

On pages 2-7 of the Office Action, the Examiner asserted that Requena discloses the claimed invention corresponding to that claimed. This rejection is respectfully traversed.

In the paragraph spanning pages 7 and 8 of the Amendment filed July 19, 2005, Applicants argued that:

Specifically, the second limitation, “determining from each request a particular location-based service provider which can service the request”, is not apparent in paragraph 12. Rather, paragraph 12 only recites the checking of a signal for “spatial location information” which can be used in “providing said presence service”. Certainly, paragraph 12 does not specify that the request can be used to determine a particular location-based service provider which can service the request. Paragraphs 37, 61 and 120 add little more in this regard. (emphasis in original)

The Examiner responded in the paragraph spanning pages 6 and 7 of the Office Action with the following:

After reviewing the claim language as well as the prior art, the examiner believes that the claimed trait is indeed taught by paragraph 12 of the prior art. The presence service is provided based on spatial location information. Hence, location is used in providing the appropriate service.

For ease of reference, paragraph [0012] of Requena is reproduced below:

According to a first aspect of the invention, a method for providing a presence service over an internet protocol network comprises the steps of receiving application layer signaling from users registering for said presence service, checking said signaling for spatial location information, and storing said spatial location information for use in providing said presence service.

At the outset, Applicants note that paragraph [0012] is only a summary and provides little descriptive detail as to the specifics involved. The above-reproduced claim limitation is as follows: "determining from each request a particular location-based service provider." The teachings in paragraph [0012], however, are silent as to a particular location-based service provider. The teaching within paragraph [0012] of "storing said spatial location information for use in providing said presence service" is not necessarily comparable to the claimed limitation. Although a location-based service provider may provide a presence service, a location-based service provider, as claimed, and a presence service, as taught by Requena, are not identical.

A rejection under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.<sup>1</sup> The disclosure of using spatial location for use in provide a presence service does not identically disclose the claimed determining from a request a

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<sup>1</sup> In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

particular location-based service provider that can service the request. Therefore, Requena fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

In first full paragraph on page 8 of the Amendment filed July 19, 2005, Applicants argued that:

Likewise, paragraphs 12, 37, 61 and 120 of Requena fails to teach specifically formatting each request according to a specific format specified by the particular location-based service provider, uniformly formatting each result set produced from corresponding ones of the requests, and forwarding the uniformly formatted result sets to the location-based service applications. (emphasis in original)

The Examiner responded in the first full paragraph on page 7 of the Final Office Action with the following:

The second element of concern involves the claimed invention's trait involving formatting results uniformly. The examiner cites and continues to believe that whenever data is sent or received, it is inherent that it must be formatted as claimed. Formatting is required since each user's device may be using a different format and multiple users are permitted within the design. Plus, the disclosure also teaches that data be transferred in a concrete format such as XML (paragraph 177).

Applicants submit that the Examiner's reliance upon the doctrine of inherency to disclose the claimed formatting is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.<sup>2</sup> To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary

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<sup>2</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

skill.<sup>3</sup> This burden has not been met. Therefore, the Examiner has not established that these limitations are inherently disclosed by Requena. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

Applicants further note that the Examiner has improperly asserted that "[f]ormatting is required since each user's device may be using a different format and multiple users are permitted within the design." In this regard, reference is made to ex parte Schricker,<sup>4</sup> in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge the burden of indicating where the Examiner's assertion appears in the prior art. Instead, the rationale behind the Examiner's assertion (i.e., formatting is required since each user's device may be using a different format) appears to be derived from Applicants' disclosure (see, for example, the paragraph spanning pages 8 and 9 of Applicants' disclosure).

Applicants further note that independent claims 1, 3, and 5 have been amended to clarify that different ones of location-based service providers specify different formats for receiving requests. Thus, the claimed "specifically formatting ..." step found in claims 1 and 5 may result in different specific formats being specified," and the uniform input interface recited in claim 3 is

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<sup>3</sup> Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

<sup>4</sup> 56 USPQ2d 1723, 1725 (BPAI 2000).

adapted to be connected to different service adapters specifying different formats for receiving requests.

In the statement of the rejection the Examiner relied on paragraph [0177] of Requena to teach that "data be transferred in a concrete format such as XML." Requena, however, fails to teach claims 1, 3, and 5, as amended in the manner described above. For example, in paragraph [0175], Requena states:

The basis of the Presence Service is first of all to define a common data structure where the user location information is specified. XML is preferred as the framework for that purpose.

Paragraph [0177], which was cited by the Examiner, is also reproduced below:

As discussed above, in this disclosure it is proposed to use the SIP as transport protocol for carrying that data format either in XML or in another concrete format.

As apparent from these teachings, Requena fails to teaching that different ones of location-based service providers specify different formats for receiving requests. Instead, it appears that a single preferred format is used. Thus, Requena fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-6 under 35 U.S.C. § 102 for anticipation based upon Requena.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

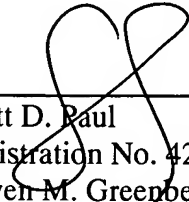
Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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